REMARKS

Claims 1-46 are pending in the above application and have been rejected in the aforementioned Office Action. In this Amendment, claims 1, 21, 28 and 30 have been amended hereinabove and Claims 2-10, 12-20, 25, 29, and 33-68 have been cancelled hereinabove. Applicants respectfully traverse each ground of rejection and request reconsideration and further examination of the application. Applicants respond to each ground of rejection and objection as follows:

A. Claims 1, 3, 6-12, 14-17, 19, 21-23, 25-38, and 41-46 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy (USPN 5,970,474), in view of Robertson (USPN 6,609,106).

Claims 3, 6-10, 12, 14-17, 19, 21-23, 25, 29, 33-38 and 41-46 have been cancelled hereinabove. Thus, the rejection of claims 3, 6-10, 12, 14-17, 19, 21-23, 25, 29, 33-38 and 41-46 is moot.

LeRoy discloses a system that allows users to use a product selection device to choose items in a retail store. The items are then communicated to a registry database on a host computer via a local area network (LAN). The registry database includes items that a user has selected using the product selection device. LeRoy also discloses a point of sale input device that identifies purchased items and updates the registry database to indicate which items have been purchased. LeRoy further discloses a system whereby registry databases at individual retail stores can be synchronized with a master registry database across a wide area network (WAN), such as the Internet.

Robertson discloses a system and method that allows users to create a gift registry including products from multiple on-line merchants. The selected items are then stored centrally in a database as elements of a wish list by sending information over the Internet to a centralized gift registry site. Robertson also discloses a system whereby individual gift purchasers can make purchases for a registrant using the wish list. The wish list items can be searched and organized by price or category. Robertson also discloses that the purchase of all items in the wish list can be delayed to a certain specified date corresponding to a future time or event. Additionally, registrants of the system can receive an automatic notification upon the arrival of the specified time or event.

As amended, independent method claim 1 requires "a concierge service for the manual purchase of selected items from physical stores; providing the concierge service with the sublist of items selected for purchase; purchasing selected items from physical stores; manually updating the wish and buy lists; wherein the concierge service updates the wish and buy lists after purchasing the items from physical stores on behalf of the buyer," and independent method claims 21, 28 and 30 have been amended to include nearly identical language. The prior art of record, alone or in combination, does not disclose or suggest an online shopping system utilizing a wish list stored in a database and electronically communicated that includes the purchase of an item from a physical store followed by manually updating the wish list, such as keying in the purchase data after hours.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the claim limitations. MPEP § 706.02(j). Specifically,

the combination cited in the most recent Office Action does not teach a concierge service making a physical purchase on behalf of a buyer or listed user. LeRoy and Robertson disclose systems in which wish lists are created and used for online shopping, but do not disclose any method or system wherein surrogate shoppers physically purchase items from online wish lists or buy lists from physical stores on behalf of buyers or listed users. While the two most recent Office Actions take Official Notice regarding concierge services in regards to claim language wherein the buyer is further identified as being a concierge service, the official Notice does not extend to situations wherein the buyer utilizes a concierge service in connection with an online wish-list based purchasing system as a means of avoiding unnecessary online exposure of financial information. Thus, the Official Notice is respectfully traversed regarding claims 1, 21, 28 and 30, as amended.

For purchases to be made under the LeRoy and Robertson systems, a buyer's credit card or bank account information would necessarily have to be transmitted online. In contrast, under the system of claims 1, 28 and 30, such information may be shared with the concierge service via a variety of more secure ways (if shared at all), the buyer/listed user might establish a credit account or prepayment with the concierge service, or the concierge service might bill the buyer/listed user after the purchases are made. Thus, even if the references of record are combined, they fail to show each of the required elements or limitations of claims 1, 21, 28 and/or 30.

Claim 11 depends from independent claim 1; claims 22, 23, 26 and 27 depend from claim 21; and claims 31 and 32 depend from claim 30 and therefore include all of the limitations of their respective base claims. It is, therefore, respectfully submitted that claims 11, 22, 23, 26, 27, 31 and 32 are each allowable over the references of record for at least the same reasons as set forth above regarding their respective base claims.

B. Claim 2 was rejected under 35 USC § 103(a) as being unpatentable over LeRoy and Robertson; claims 4-5, 18, 20, and 24 were rejected under, as applied to Claims 1, 3, 12, and 22, further in view of Official Notice (regarding access control lists).

Claims 2, 4, 5, 18, 20, 39, 40, 47-68 have been cancelled hereinabove. Thus, the rejection of claims 2, 4, 5, 18, 20, 39, 40, 47-68 is moot.

Claim 24 depends from Claim 21 and is therefore allowable for the reasons stated above with respect to Claim 21.

C. Claim 13 was rejected under 35 USC § 103(a) as being unpatentable over LeRoy and Robertson, as applied to Claim 12, further in view of Kraemer.

Claim 13 has been cancelled hereinabove. Thus, the rejection of claim 13 is moot.

In the event Applicants have overlooked the need for an extension of time or payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 50-0410, BINGHAM McHALE LLP.

CONCLUSION

Reconsideration of the present application in view of the foregoing arguments is respectfully requested. Applicants respectfully submit that the above represents a complete response to the Office Action of November 17, 2004, and that the application is in condition for allowance. Such action is respectfully requested.

Respectfully submitted,

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